



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,667	08/24/2001	Masutomi Ohta	58799-047	1045

7590 10/05/2004

McDermott, Will & Emery
600, 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
----------	--------------

2645

5

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,667

Applicant(s)

OHTA ET AL.

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 11-30 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 9 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1.1 Claim 11 recites the limitation "said reception signature" in line 3. There is insufficient antecedent basis for this limitation in the claim.

1.2 Claim 16 recites the limitation "the visitor" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2645

2. Claims 17, 18 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolf US 5,875,232.

2.1 Regarding claim 17, Wolf discloses a personal computer (apparatus) 10 in figure 1 (column 2, lines 53-64), comprising:

a receiver (computer 10) for receiving a caller ID signal (first signal) from a first transmitter (telephone network), said first signal including a caller ID (first data) (column 3, lines 14-17);

a transfer unit (computer 10) for comparing said caller ID with a set of second data (caller IDs) pre-stored in a memory, and transmits a second signal (voice prompt) to a caller depends on the comparing result (column 3, lines 17-24).

2.2 Regarding claim 18, a telephone network automatically transmits a call ID signal between first and second rings.

2.3 Regarding claim 25, it is inherent that a personal computer can be connected to a wireless network, and has an antenna for receiving WIFI signals.

3. Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Foti US 5,577,103.

3.1 Regarding claim 17, Foti discloses a MSC 12 in figure 1, comprising:

a receiver configured to receive a first signal (registration request message 14), from a first transmitter (mobile station MS 11), said first signal including first data (identification of MS 11) (column 3, lines 55-59);

a transfer unit for comparing first data with a set of second data (registered identifications) pre-stored in a memory, and based on a comparing result, transmits a second signal (registration accept message 16) to the MS 11 (column 3, lines 59-65).

3.2 Regarding claim 18, Foti teaches that the first transmitter transmits the first signal automatically (column 3, lines 5-59).

4. Claims 17, 24 and 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Blood et al. US 6,456,706.

4.1 Regarding claim 17, Blood discloses a telephone screening apparatus 1 (security apparatus) in figures 1 and 4. Blood teaches:

a receiver (DTMF decoder) 105 for receiving a first signal (DTMF tone) from a first transmitter (caller's telephone), said first signal including first data (access code) (column 4, lines 30-40); and

a transfer unit (CPU 100, and call forwarding 62 in figure 5) for comparing said first data with a set of second data (access codes) pre-stored in a memory 111 (column

Art Unit: 2645

4, lines 40-42), said transfer unit configured to selectively transfer a second signal (outgoing call) depending on said comparing result (column 7, lines 22-25, 60-67; column 7, lines 1-2).

4.2 Regarding claim 24, Blood teaches matching an access code with a pre-stored one in a memory, and transferring a call to a particular individual (column 7, lines 64-67).

4.3 Regarding claim 26, Blood teaches a time code 4 for blocking all telephone calls (column 15, lines 3-4) (second operating condition).

4.4 Regarding claim 27, Blood teaches a communication device RS-232 interface for connecting the telephone screening apparatus 1 to a computer. The RS-232 interface transmits decoded signal (third signal) while said received (DTMF decoder) reads the first signal (column 6, lines 55-67).

4.5 Regarding claim 28, Blood teaches the availability of data stored in memory 111 depend on a time code (column 14, lines 65-67; column 15, lines 1-18).

4.6 Regarding claims 29 and 30, it is inherent that a caller's telephone can be cellular phone.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 8, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepper et al. US 5,930,700.

5.1 Regarding claim 1, Pepper discloses a telephone network interface (TNI) 304, a service control module 306 and a database 308 in figure 3. Pepper teaches:

means for acquiring a telephone number (caller ID) of a caller from an incoming call (column 6, lines 12-22, 65-67);

a phonebook database for storing at least one phone number of a caller (column 6, lines 30-33);

a transfer judgment means for comparing said phone number acquired with at least one telephone number stored in the phonebook database, and determine whether to transfer said incoming call to a PDA based on received caller ID (column 6, lines 33-42); and

notifying the PDA of said incoming call, and connecting the caller to the user of said PDA (column 6, lines 37-46; figure 10).

Pepper further teaches communicating with a cellular telephone 130 (figure 1), but fails to specifically teach that said incoming call is from a visitor with a cellular telephone.

However, it is obvious that when Mr. Smith (visitor), equipped with a cellular telephone, planed a visit to Mr. Jones' house. Mr. Smith would have called Mr. Jones on his way to, or before arriving at Mr. Jones' house to make sure that Mr. Jones was available. Therefore, said incoming call would have been come from a visitor with a cellular telephone, and said caller ID would have been the cellular telephone number.

5.2 Regarding claim 2, Pepper discloses a telephone network interface (TNI) 304, a service control module 306 and a database 308 in figure 3. Pepper teaches:

means for acquiring a telephone number (caller ID) of a caller from an incoming call (column 6, lines 12-22, 65-67);

a phonebook database for storing at least one phone number of a caller (column 6, lines 30-33); and

a transfer judgment means for comparing said phone number acquired with at least one telephone number stored in the phonebook database, and determine whether to transfer said incoming call to a PDA based on received caller ID (column 6, lines 33-42).

Pepper further teaches communicating with a cellular telephone 130 (figure 1), but fails to specifically teach that said incoming call is from a visitor with a cellular telephone.

However, it is obvious that when Mr. Smith (visitor), equipped with a cellular telephone, planed a visit to Mr. Jones' house. Mr. Smith would have called Mr. Jones on his way to, or before arriving at Mr. Jones' house to make sure that Mr. Jones was available. Therefore, said incoming call would have been come from a visitor with a cellular telephone, and said caller ID would have been the cellular telephone number.

5.3 Regarding claim 8, Pepper teaches that the telephone numbers stored in the database 308 are transmitted from a PDA (security company server) (column 5, lines 33-38).

5.4 Regarding claim 13, Pepper discloses a telephone network interface (TNI) 304, a service control module 306 and a database 308 in figure 3. Pepper teaches:

TNI 304 (security apparatus) for acquiring a telephone number (caller ID) of a caller from an incoming call (column 6, lines 12-22, 65-67);

a service control module 306 (security company server) with a database 308 (memory) for storing at least one phone number of a caller (column 6, lines 30-33); and

service control module 306 (transfer judgment unit) for comparing said phone number acquired with at least one telephone number stored in the database, and determine whether to transfer said incoming call to a PDA based on received caller ID (column 6, lines 33-42); and

notifying the PDA of said incoming call, and connecting the caller to the user of said PDA (column 6, lines 37-46; figure 10).

Pepper further teaches communicating with a cellular telephone 130 (figure 1), but fails to specifically teach that said incoming call is from a visitor with a cellular telephone.

However, it is obvious that when Mr. Smith (visitor), equipped with a cellular telephone, planed a visit to Mr. Jones' house. Mr. Smith would have called Mr. Jones on his way to, or before arriving at Mr. Jones' house to make sure that Mr. Jones was available. Therefore, said incoming call would have been come from a visitor with a cellular telephone, and said caller ID would have been the cellular telephone number.

5.5 Regarding claim 14, Pepper teaches that if the telephone number is not matched, the call is deposited according to a user's preference (figure 12, step 1218; column 11m, lines 60-64; column 12, lines 1-4), such as routing to voice mail (security company server) or other destination (column 11, lines 5-7).

5.6 Regarding claim 16, Pepper discloses a telephone network interface (TNI) 304, a service control module 306 and a database 308 in figures 3. Pepper teaches:

means for acquiring a telephone number (caller ID) of a caller from an incoming call from a SCP (security apparatus) (column 6, lines 12-22, 65-67);

a phonebook database (memory) for storing at least one phone number of a caller (column 6, lines 30-33); and

a transfer judgment means for comparing said phone number acquired with at least one telephone number stored in the phonebook database, and determine whether

to transfer said incoming call to a PDA based on received caller ID (column 6, lines 33-42).

Pepper further teaches communicating with a cellular telephone 130 (figure 1), but fails to specifically teach that said incoming call is from a visitor with a cellular telephone.

However, it is obvious that when Mr. Smith (visitor), equipped with a cellular telephone, planed a visit to Mr. Jones' house. Mr. Smith would have called Mr. Jones on his way to, or before arriving at Mr. Jones' house to make sure that Mr. Jones was available. Therefore, said incoming call would have been come from a visitor with a cellular telephone, and said caller ID would have been the cellular telephone number.

6. Claims 3, 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepper et al. US 5,930,700 in view of Rosa US 5,633,914 and further in view of daSilva US 6,445,937.

Pepper teaches transferring an incoming call, from a visitor's cellular telephone, to a user's PDA as discussed in claims 1 and 2, but fails to teaches that the cellular telephone periodically transmits its telephone number to a base station.

However, Rosa teaches that a cellular telephone periodically transmits its mobile identification number (MIN) to a wireless network (column 1, lines 22), and daSilva teaches that a MIN is the telephone number of a cellular telephone (column 1, lines 58-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Pepper's reference with the teachings of Rosa and daSilva, so that a cellular telephone would have periodically transmitted its telephone number to a base station, because such a modification would have clarified how a cellular telephone's number was obtained.

7. Claims 1, 2, 5, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukui Japanese Patent Publication No. 11-136376 in view of Kuno Japanese Patent Publication No. 61-126851 and further in view of Blood et al. US 6,456,706.

7.1 Regarding claims 1 and 2, Fukui discloses a door phone with a handset located at the entrance of a house, so that a visitor may use it to call the resident of the house. If the resident is not in the house, the call is transferred to another phone, or a PDA by an auto-dialer 15 (Abstract of 11-136376; page 2, lines 205 of Specification of current invention). Fukui fails to teach acquiring a telephone number of a cellular phone carried by said visitor, and compare said telephone number with a pre-stored number in a database.

However, Kuno discloses a door phone in that a visitor is asked to input a valid code in order to be transferred to another telephone available to a out-of-home homeowner (Abstract).

In addition, Blood discloses a customer premises screen device 1. Blood teaches that a caller is required to input a valid code for the device to transfer an incoming call to a called party when the called party is away (column 3, lines 31-33; column 4, lines 30-42, 58-66; column 7, lines 22-25, 60-67; column 8, lines 1-2). Blood further teaches that the code is the last four digits of the telephone number of the caller, and optionally, the code may have more than four digits (column 14, lines 16-18; column 16, lines 38-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Fukui's reference with the teachings of Kuno and Blood, so that a caller would have been prompted to enter an access code such as a telephone number of his cellular phone, in order to be connected to the resident of the house, and the access code would have been compared to pre-stored telephone numbers to determine if a valid access code had been entered, and such a modification would have filtered out unwanted visitors.

7.2 Regarding claim 5, Fukui teaches a camera 25 for taking a photo of said visitor and a microphone 23 for receiving audio inputs from said visitor (Abstract of 11-136376; page 2, lines 2-5 of Specification of current invention).

7.3 Regarding claim 9, as discussed in claim 2, Fukui teaches a camera 25 for taking an image, which inherently can be a signature.

Art Unit: 2645

7.4 Regarding claim 11, Fukui teaches a camera 25 for taking an image and a memory 13 for storing said image.

7.5 Regarding claim 12, Fukui teaches a camera 25 for taking photos to be transmitted to a PDA (Specification of current invention, page 2, lines 2-5). It is inherent that the camera is able to take a photo of a package for transmitting to said PDA.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foti US 5,577,103 in view of Rosa US 5,633,914.

Foti teaches that the first transmitter (mobile station 11) transmits the first signal, including the identification of the mobile station 11, to the MSC 12. Foti fails teach that the first signal is transmitted periodically.

However, Rosa teaches that cellular telephone periodically transmits its mobile identification number and electronic serial number to a wireless network (inherently, through a base station) (column 1, lines 17-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Foti's reference with the teaching of Rosa, so that the first signal would have been transmitted periodically, because such a modification would have clarified the operation of a wireless network.

9. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blood et al. US 6,456,706 in view of Pepper et al. US 5,930,700.

9.1 Regarding claim 20, Blood teaches transferring an incoming call to another telephone, but fails to teach that another telephone is a wireless device, such as PDA.

However, Pepper teaches transferring an incoming call to PDA, if a caller's ID matches one specific pre-stored telephone number (figure 4; column 1, lines 36-44; column 6, lines 13-22, 30-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Blood's reference with the teaching of Pepper, so that an incoming call would have been transferred to a PDA, because such a modification would have enabled Blood's device to transfer calls to wireless devices.

9.2 Regarding claim 21, it is inherent that for Blood's device to transmit a signal to a wireless device, such as PDA, the blood's device is coupled to a base station (second transmitter) of a wireless network.

9.3 Regarding claim 22, the communication of the modified Blood's device and the PDA, is visual (Pepper; column 6, lines 37-46; figure 10).

9.4 Regarding claim 23, caller information is stored in PDA (figure 10 of Pepper).

Allowable Subject Matter

10 Claims 6, 7, 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11 The following is a statement of reasons for the indication of allowable subject matter:

11.1 Claims 6 and 7: The current invention discloses method and apparatus for comparing an acquired telephone number with pre-stored telephone numbers in a database, and notifies a PDA unit if a match is found, and if there is no match, forwarding the acquired telephone number to a security company's server, and then notifies a PDA unit base on the determination of the server. Prior art issued to Peeper (US 5,930,700) fails to teach transferring the acquired telephone number to a server, and then notifying a PDA unit based on the determination of the server if there is no match.

11.2 Claim 9: In addition for comparing an acquired telephone number with pre-stored telephone numbers in a database, and notifies a PDA unit if a match is found. Applicant

further discloses a reception unit for receiving authorized reception signature, and issuing reception signature. Japanese Patent publication 11-136376 fails to teach such reception unit.

11.3 Claim 10, since it is a dependant of claim 9, therefore it would have been allowed.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Chern et al. US 4,764,953 discloses a remote doorbell answering device.
- b) Eckstein US 5,303,300 discloses a security door phone device.
- c) Couse US 6,006,088 discloses a device for connecting a door intercom to a cordless phone.
- d) Stuart US 5,784,446 discloses a doorbell apparatus for dialing a remote telephone.
- e) Trell US 6,606,376 discloses door phone for communicating with a public telephone network.

13. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



S.S.

09/28/2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

